



In Re Application Of: David O. McGoveran  
Serial No. 09/476,711  
Filed: Dec. 30, 1999  
For: A Declarative Method

Examiner: Andre Boyce  
Group Art Unit: 3623  
Atty. Docket No: McG-003  
Date: May 25, 2006

**Claim Rejections under 35 USC §112**

The OA objected to Claim 112, and thus to those claims (113-190) dependent upon it, and to Claims 191 and 192, for incorporating terms with insufficient antecedent basis. These claims have been amended to correct these inadvertent omissions and errors, and so the rejection has been traversed.

## **Claim Rejections Under 35 USC §101**

The OA rejected Claims 112-192 as directed to non-statutory subject matter. In Ex Parte Carl A. Lundgren (heard 04/20/04) the Board of Patent Appeals determined *per curiam* that an §101 objection not grounded on the limited and specifically listed bases for exclusion found in Diamond v. Diehr, 450 U.S. 175, 185; 209 USPQ 1, 7 (1981) – those specifically listed bases being “laws of nature, physical phenomena and abstract ideas” – must fail. Those specifically listed bases are not cited in this OA, and the Board strongly discouraged any assertion of a separate “technological arts” test, stating:

“Our determination is that there is currently no judicially recognized separate “technological arts” test to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner’s rejection can not be sustained.”

The OA failed to mention a specific sub-step of Claim 112 that addresses this particular objection, that perhaps was overlooked. Claim 112 specifically states a limitation of:

“(j) executing automatically at least a subset of the dynamic pattern of operations...”.

The result of this substep is described in the Specification as follows:

“This allows the business to continually modify its actual operation to the most effective set and dynamic pattern of operations by letting the real-world conditions, rather than an externally-imposed preconceived hierarchy of operations, dominate the business’ behavior and interactions with the real-world...” (p. 18)

To make this substep more evident to non-practitioners, and to address the concerns of the OA, Claim 112 has been amended. The above-mentioned specific limitation of sub-step (j) now incorporates functional language such that:

“executing automatically at least a subset of the dynamic pattern of operations”,  
effects

“that [which] progresses towards said Objective”.

Claim 192 has also been amended to incorporate a specific new limitation addressing this point, to wit:

“means for using said set of steps of declaring, stating, delegating, determining, and modifying, to further the attainment of a Goal of said first dynamic process independent of human action;”.

On complete reading of the entire claim as amended for Claims 112 and 192, the totality thereof and this specific and explicit limitation effect a useful, concrete, and tangible result – i.e. that which moves the first dynamic process, and thus a business’s operation, towards attainment of the stated Goal(s) within the Constraints of action and decision.

Adapting a business’s operation to the ‘most effective set’ means saving money, time, and effort – any or each of which is a practical and thus useful result. Generations of IT professionals have and do make a livelihood automating even a sub-portion of a business to save money, time, and effort, establishing that the marketplace considers these to be ‘useful, concrete, and tangible’ – and eminently practical – effects.

The utility requirement is a minimal threshold. The law holds that “An invention is ‘useful’ under section 101 if it is capable of providing some identifiable benefit.” Juicy Whip, Inc. v. Orange Bang, Inc. 185 F.3d 1364, 51 USQP 2d 1700, 1702 (Fed. Cir. 1999). In fact, the bias favors the inventor; the PTO must prove a complete failure of utility, or, as the court said, “To violate 101 the claimed device must be totally incapable of achieving a useful result.” [citations omitted]; Brooktree Corp. v. Advanced Micro Devices, Inc. 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992).

Furthermore, the OA did not deny the assertion in the prior Response of multiple, specific, separate tangible results that are produced by the Applicant’s invention. These are more clearly enumerated in several specific dependent claims, as well as already mentioned in the Specification. Five of the many tangible results are: (1) the instantiation of a tangible, reproducible, transferable and thus saleable, model of a business’ knowledge (Specification, p. 13, lines 24-30; Claim 142); (2) instantiation (in a recorded

form) of a tangible store of a business' human employees' knowledge of its operations that is capitalized, i.e. contained outside of the human employees' minds (Specification p. 13, line 30 to p. 14, line 3; Claim 141); (3) the reduction of risk and thus decrease in operational loss and cost, both for operations (Specification, p. 23, lines 20-26) and for delegation (Specification, p. 23, line 27 to p. 24, line 2; Claims 131 and 148); (4) making process information accessible and susceptible to comparison and improvement as it is both made explicit rather than implicit and tied to measurement (Specification, p. 19, lines 6-7; Claims 143, 150, 163).

Most particularly, the OA may have overlooked the specific dependent claims whereby any contradiction contained within the process is transformed, becoming not a source of error requiring external corrective intervention, but a source for and means of auto-correction (Specification, p. 19, lines 18-25; Claims 167, 169-173). This specifically is a solution which no prior business method nor computer software implementation nor methodology disclosed by Examiner or known to Applicant or the independent expert first referenced by the PTO, had ever seen before.

Applicant again humbly requests that specific notice be taken of the affidavit of Professor Hossein Bidgoli – an independent, third-party expert who was first referenced by the PTO – who has declared of Applicant's invention:

“Those with ordinary skill as described above, upon reading the inventor's application, would appreciate the invention's usefulness. Its advantages were clearly stated.” See *Bidgoli Declaration*, on file.

Neither evidence nor reason is offered to support the OA's assertion “these limitations provide no practical application...”. Specific, factual reasons that would lead one skilled in the art to question the applicant's statement of must be provided for a challenge to be valid, In re Gaubert, 524 F.2d 1222, 187 USPQ 664, 666 (CCPA 1975).

In the absence of any such warrant, the specific assertion of utility from the independent, third-party expert already on file must prevail.

As the OA does not list any contrary evidence, this determination of usefulness is currently unchallenged and dispositive.

Accordingly, this grounds for rejection is traversed.

**Claim Rejections — 35 USC §103:**

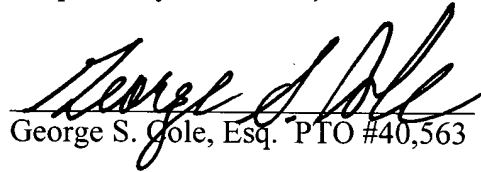
The OA asserted that Claim 191 is rejected as unpatentable over Tinnirello in view of Davis. The OA conceded that Tinorello “does not explicitly disclose incorporating a dynamic pattern of operations driven by real world conditions, through which at least a first behavioral pattern emerges”.

Although Applicant feels that this Claim is – or at least with minor modifications could be made to be – valid, in a spirit of cooperation and compromise this Claim is cancelled.

## Conclusion

For all the reasons given above, it is respectfully submitted that the actual errors in the specification are corrected, that the claims comply with the requirements of Sections 101 and 112, that the claims define over the prior art a new and non-obvious combination over Sections 102 and 103, and that as the third party witnesses have already declared, these distinctions attain concrete, tangible, and useful results and are of patentable merit. Accordingly, this application is now submitted to be in full condition for allowance, which action is respectfully solicited.

Respectfully Submitted;



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